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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,151	01/25/2002	Yihan Liu	DC4978	9548

7590 09/22/2003
Dow Corning Corporation
Intellectual Property Department
P.O. Box 994
Midland, MI 48686-0994

EXAMINER

JIANG, SHAOJIA A

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 09/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/055,151

Applicant(s)

LIU ET AL.

Examiner

Shaojia A Jiang

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 2-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 9-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Applicant's preliminary amendment in response to the Restriction Requirement, submitted July 9, 2003 in Paper No. 4 is acknowledged, wherein claims 9-12 are newly submitted. Currently, claims 1-12 are pending in this application.

Election/Restrictions

Applicant's election without traverse of the invention of Group I, Claim 1, drawn to a method of making a silicone oil-in-water emulsion cosmetic composition herein, in Paper No. 4, submitted July 9, 2003 is acknowledged.

Since the new claims 9-12 are also drawn to a method of making a silicone oil-in-water emulsion cosmetic composition herein, claims 9-12 will be examined with claim 1 on the merits herein as Group I.

Claims 2-8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claim Objection

Claims 1 and 9 are objected under 37 CFR 1.75 as being a substantial duplicate of claims to each other. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claims 11 and 12 are objected under 37 CFR 1.75 as being a substantial duplicate of claims to each other since an alcohol recited in claim 11 is also considered to be a solvent recited in claim 12, in particular "an alkane containing less than about 16 atoms".

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 9-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation "a desired molecular weight" in lines 4, 7, and 8 of claims 1 and 9 renders claims 1 and 9-12 indefinite. The recitation "a desired molecular weight" is not clearly defined in the specification. Thus, one of ordinary skill in the art could not interpret the metes and bounds of the patent protection desired as to what "a desired molecular weight" is in the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1617

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Kasprzak (US 5,443,760, PTO-1449 submitted January 25, 2002).

Kasprzak discloses a method of making the instant silicone oil-in-water emulsion composition comprising the particular instant steps for the making herein and the particular components employed in the method (see abstract, col.2-4, and claims 1-8). Kasprzak also discloses the employment of the instant particular components such as the salt, i.e., sodium chloride, aluminum chloride, or ammonium chloride (see col.6 lines 40-45); a lower alkyl alcohol, i.e., ethanol and isopropanol, or a solvent herein such as propyl and octyl esters, fatty alcohols (see col.4 lines 64-68).

Thus, the disclosure of Kasprzak anticipates claims 1 and 9-12.

Claims 1 and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Gee et al. (US 5,891,954, PTO-1449 submitted January 25, 2002).

Gee et al. discloses a method of making the instant silicone oil-in-water emulsion composition comprising the particular instant steps for the making herein and the particular components employed in the method (see abstract, col.2-4, and claims 1-17). Gee et al. also discloses the employment of the instant particular components such as the salt, i.e., ammonium chloride (see col.6 lines 23-30); a lower alkyl alcohol, i.e., ethanol (see Example XIV at col.10 lines 19-20), or a solvent herein such as fatty alcohols, ethers or aromatic compounds (see col.4 lines 58 to col.6 line 58).

Thus, the disclosure of Gee et al. anticipates claims 1 and 9-12.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 9-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 5,443,760.

Although the conflicting claims are not identical, they are not patentably distinct from each other. As discussed above, the instant claims 1 and 9-12 are seen to be anticipated by the claims 1-8 of U.S. Patent No. 5,443,760 (see supra at page 4).

Claims 1, 9, and 11-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,593,422.

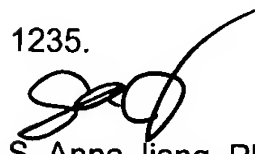
Although the conflicting claims are not identical, they are not patentably distinct from each other. As discussed above, the instant claims 1 and 9-12 are seen to be anticipated by the claims 1-17 of U.S. Patent No. 5,891,954 (see supra at page 4).

In view of the rejections to the pending claims set forth above, no claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (703) 305-1008. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.



S. Anna Jiang, Ph.D.
Patent Examiner, AU 1617
September 15, 2003